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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,618	10/26/2001	Steven O. Markel	INTE.20USU1 (ITC18)	4807

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EXAMINER	
SHELEHEDA, JAMES R	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 11/07/2003 6

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/046,618	MARKEL ET AL.	
	Examiner	Art Unit	
	James Sheleheda	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) *8-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5 and 6*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-7 and 13, drawn to method for selecting and displaying video segment based on a user's affinity data, classified in class 725, subclass 13.

   II. Claims 8-12, drawn to method of rewarding viewers, classified in class 725, subclass 23.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the mere step of rewarding viewers is generic. The subcombination has separate utility such as rewarding viewers in an Internet environment.

2. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

3. During telephone conversations with Paul Thompson on 10/21/03, and Bill Cochran on 10/24/03, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-7 and 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawler (5,758,259).

As to claim 1, Lawler discloses a method of selecting and displaying a video segment to a viewer comprising: transmitting a plurality of video segments from a broadcast center to a viewer (column 1, lines 63-65), displaying said video segments to said viewer (column 1, lines 65-67 and column 2, lines 1-2), sensing input from said viewer through at least one sensor (infrared input, column 4, lines 58-61), transmitting said input to a remote computer (column 7, lines 35-47), analyzing said input to generate affinity data (column 5, lines 52-59 and column 7, lines 54-61), selecting a specific video segment based on said affinity data (column 9, lines 36-43), transmitting said specific video segment from said broadcast center (IT system, 10) to said viewer (column 2, lines 3-9 and column 9, lines 19-26), and displaying said specific video segment to said viewer (column 9, lines 19-26).

As to claim 2, Lawler discloses wherein said sensor comprises at least one button pressed by a viewer (column 4, lines 58-67 and column 5, lines 1-7).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Shah-Nazaroff et al. (Shah-Nazaroff)(6,317,881).

As to claim 13, Shah-Nazaroff discloses a method of providing broadcast content viewing information comprising: implementing an award method wherein viewers are awarded a value for responding to events associated with presentation of said broadcast content (column 3, lines 32-47), said method comprising: receiving responses to said presentation of said broadcast content from said viewers (column 3, lines 32-47), analyzing said responses received from said viewers (column 3, lines 48-67 and column 4, lines 1-26) and generating affinity data from said analysis (column 4, lines 20-26).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler as applied to claim 1 above, and further in view of Hite et al. (Hite)(6,002,393).

As to claim 3, Lawler discloses the selecting of a video segment during a broadcast based upon affinity data. However, Lawler fails to disclose the selection of a video segment during a live broadcast.

Hite discloses a method for selecting a specific commercial segment during live broadcasts (column 13, lines 7-18) for the advantage displaying targeted video during sports contests and other live events.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Lawler's system to include the selecting of a video segment during a live broadcast, at taught by Hite, for the advantage of targeting viewers based on their needs and interests during live events.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler, in view of Shah-Nazaroff.

As to claim 7, Lawler discloses all of the claim limitations except a method which further comprises rewarding said viewers for responding with said input to said video segments.

Shah-Nazaroff, however, discloses a method of rewarding viewers with an incentive, such as a discount, for responding with an input during a video segment (column 3, 32-47) for the advantage of getting more viewers to watch and respond to the video programming.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Lawler's method to include the rewarding of viewers for responding with inputs to video segments, as taught by Shah-Nazaroff, for the typical advantage of encouraging a greater number of viewers to view and input responses to a particular video segment.

12. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler, in view of Hendricks et al. (Hendricks)(6,463,585).

As to claim 4, Lawler discloses a method of collecting affinity data comprising: transmitting a plurality of video segments from a broadcast center to a viewer (column 1, lines 63-65), displaying said video segments to said viewer (column 1, lines 65-67 and column 2, lines 1-2), sensing input from said viewer through at least one sensor (infrared input, column 4, lines 58-61), analyzing said input to generate affinity data (column 5, lines 52-59 and column 7, lines 54-61), selecting a specific video signal (column 9, lines 19-26) from a plurality of video signals being broadcast to said viewer (column 2, lines 20-29), said selection being based on said affinity data (column 9, lines 36-43), and displaying said specific video segment to said viewer (column 9, lines 19-26). However, Lawler fails to disclose the transmitting of affinity data to a remote computer.

Hendricks discloses the storing of affinity data on a set top for later transmission to a remote computer (column 28, lines 17-31) for the typical advantage of enabling affinity data to be available immediately for use in broadcast programming selection.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Lawler's method to include the gathering of affinity data on a set top for transmission to a remote computer, as taught by Hendricks, for the typical advantage of the immediate availability of the affinity data for a viewer's program selection.

As to claim 5, Lawler and Hendricks disclose wherein said sensor comprises at least one button pressed by a viewer (See Lawler at column 4, lines 58-67 and column 5, lines 1-7).

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler and Hendricks as applied to claim 4 above, and further in view of Hite.

As to claim 6, Lawler and Hendricks disclose the selecting of a video segment during a broadcast based upon affinity data. However, Lawler and Hendricks fail to disclose the selection of a video segment during a live broadcast.

Hite discloses a method for selecting a specific commercial segment during live broadcasts (column 13, lines 7-18) for the advantage displaying targeted video during sports contests and other live events.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Lawler and Hendrick's system to include the selecting of a video segment during a live broadcast, at taught by Hite, for the advantage of targeting viewers based on their needs and interests during live events.

Conclusion

14. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually

depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

_____

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

_____

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful the primary examiner, Christopher Grant, can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-HELP.

James Sheleheda
Patent Examiner
Art Unit 2614

JS

Chris Grant
CHRIS GRANT
PRIMARY EXAMINER